

REMARKS

Reconsideration of the subject patent application is respectfully requested.

In the first Office Action, all twenty (20) claims, as originally filed, have been rejected. More specifically, claims 1 and 14 stand rejected under 35 U.S.C. §102(b) as being anticipated by Dwinell et al. Claims 1-2 and 14-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schmitz et al. in view of Parish. Claims 2 and 15-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dwinell et al. in view of Fernandes. Claims 3 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dwinell et al. in view of Fernandes and further in view of Korn. Claims 4-5 and 18-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dwinell et al. in view of Fernandes and in view of Korn and further in view of May. Claims 4-6 and 18-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dwinell et al. in view of Fernandes and in view of Korn and further in view of Gach. Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over Dwinell in view of Korn. Claims 8-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dwinell in view of Korn and further in view of May. Claims 8-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dwinell in view of Korn and further in view of Gach. Claims 11-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dwinell in view of May. Claims 11-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dwinell in view of Gach.

In response to the Office Action and the rejection of all twenty claims, independent claims 1 and 14 have been amended and claims 21-23 have been added. Several other claims have been canceled or amended for consistency and compatibility with what has been done with respect to claims 1 and 14.

In the amendment of claims 1 and 14, there is one very important point of clarification. The pair of spaced apart thinner portions 33 and 34 were described in the specification (page 4) initially as V-shaped notches and later as weakened score lines. This portion of the specification also explains, in describing the function, that these two strips “act like living hinges”. As would be clear from an understanding of the present invention, these two strips are intended to function as hinge strips so that the outer sections of the overcap can be pivoted in an upward direction to facilitate the unthreading of the overcap from its threaded connection with the container closure plug. Since these two living hinge strips are never intended to be severed, as one might think in terms of tearing a strip free from defining score lines, the preferred terminology is “living hinge strips”, rather than score lines.

Since the flange sections are used to hingedly pivot the first and second outer sections about strips 33 and 34, respectively, it is important for the center post to be connected to only the center section, as would be the result of being positioned between the two living hinge strips. Otherwise, if the center post connection extended outside of the living hinge strips, lifting up on the outer sections could not be effected without first breaking the connection with the center post. This simply represents an added cost and an unnecessary requirement for the claimed overcap.

Additionally, claims 1 and 14 have been amended to recite that the first and second pins are unitarily connected to a corresponding one of the outer sections and are received by the container closure plug.

With regard to the various rejections and the amending changes, the cited references that the Examiner will likely consider are Dwinell in combination with Fernandes and one or more of Korn, May, and Gach. The Examiner has also cited the combination of Schmitz et al. and Parish, but this combination of references was not applied to original claims 4 and 5. Consequently, the addition of the first and second pins into claims 1 and 14 would seem to make the combination of these two patents a moot point. Nevertheless, these two patents do not disclose any type of center section defined by living hinge strips with a cooperating center post that is unitarily connected to only that center section.

In reviewing all of the cited art, none of the patents identified by the Examiner disclose any type of center section that is defined by a pair of living hinge strips. Additionally, the patents cited by the Examiner do not disclose this type of center section with a unitarily connected center post that in turn assembles into a closure plug. There is nothing in any of the cited patents that suggests or teaches or that would motivate one to combine a variety of features to try and create the claimed invention, even if all of the claimed features were in fact present in the prior art, which they are not. While some of the art may be broadly interpreted as having some type of center portion, those portions are not defined by a pair of spaced apart living hinge strips whose purpose is to allow the outer sections to pivot or hinge in an upward direction. Even with a broader interpretation of some of the references with regard to the center section and even treating

score lines intended for tearing as living hinges, these structures do not have the unitarily connected center post that lays between the pair of living hinge strips. As would be noted, the only three section construction is arguably Dwinell et al., but the scores lines are there to be severed and are not configured nor intended to be configured as living hinge strips. Further, the segmented collet is not located between the score lines. There are no other sections designed to pivot as part of the proper removal process.

Over the years the Court of Customs and Patent Appeals (CCPA) and more recently the Court of Appeals for the Federal Circuit (CAFC) have addressed the issue of what criteria is to be applied when combining two or more references under 35 U.S.C. §103. While the facts may differ from case to case and while the CAFC panel may change, the legal precedent established by the Board of Patent Appeals and Interferences and the CCPA has been followed and strengthened by the later cases of the CAFC. Clearly and succinctly stated, before obviousness may be established, the examiner must show that there is either a suggestion in the art to produce the claimed invention or a compelling motivation based on sound scientific principles. Ex parte Kranz, 19 USPQ2d 1216, 1218 (Bd. Pat. App. & Inter., 1990). The case law makes it clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is vigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340 (Fed. Cir. 1998). Obviousness cannot be established by combining the teachings of prior art in order to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. In re Geiger, 2 USPQ2d 1276 (Fed. Cir. 1987). It is improper to reject the claimed invention for obviousness when nothing in the cited

references, either alone or in combination, suggests or teaches the claimed invention. Evidence of teaching or suggestion is “essential” to avoid hindsight. In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988). Stated slightly differently, the mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence the claimed invention, obvious unless the desirability of such modification is suggested by the prior art. In re Fritch, 23 USPQ2d 1780 (Fed. Cir. 1992).

It is generally accepted, however, that it is improper to change the basic principle under which the primary reference was intended to operate. In re Ratti, 123 USPQ 349 (CCPA 1959). It is not enough to pick out isolated features in earlier prior art patents, combine them in one particular way with the application of hindsight acquired only from the applicant’s own disclosure, and then say that it would have been obvious to select those particular features and to combine them in the particular way in which the applicant has. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. There must be some teaching or suggestion in the references to support their use in the particular claimed invention. Smithkline
Diagnostics, Inc. v. Helena Laboratories Corp., 8 USPQ2d 1468 (Fed. Cir. 1988).

There must be some logical reason apparent from positive concrete evidence in the record that justifies a combination of primary and secondary references. In re Regel, Buchel and Plempel, 188 USPQ 136 (CCPA 1975). It is insufficient to show merely that each separate element of a claimed combination can be found in one or various prior art references. The mere fact that it is possible to find two isolated disclosures which might be combined in such a way to produce a new invention does not necessarily render such

new invention obvious unless the prior art also contains something to suggest the desirability of the combination. In re Gergen, 11 USPQ2d 1652, (Fed. Cir. 1989).

It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Wessslau, 147 USPQ 391, (CCPA, 1965), Bausch & Lomb v. Barnes-Hind/Hydrocurve, 230 USPQ 416 (CAFC, 1986). Without the benefit of applicant's disclosure, a person of ordinary skill in the art would not know what portions of the reference to consider and what portions to disregard as irrelevant, or misleading. In re Mercier, 185 USPQ 774 (CCPA, 1975). Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. Interconnect Planning Corp. v. Feil, 774 F2d 1132 (Fed. Cir. 1985).

In view of the amending changes that have been made, and in consideration of the arguments and analysis, claims 1-3, 6-7, 10, 13-16, and 20-23 are in condition for allowance and are respectfully requested to be passed to issue.

Respectfully submitted,

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